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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

CAMERON, ERMA C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 02/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,085

Applicant(s)

DULIN ET AL.

Examiner

Erma C. Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the claims of Group I, claims 1-13 in Paper No. 11, filed 12/20/2002 is acknowledged.

2. Claims 14-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Drawings

3. Figure 8b should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a) Claim 1: preselected is vague and indefinite, in that it adds no meaning to the claim.
- b) Claim 1: heat and period of time (used twice) have not been defined, and could mean almost anything.
- c) Claim 1: it is not clear if the curing agent actually cures the transparentizing material or not.
- d) Claims 3 and 4: period of time is vague in that it has not been defined.
- e) Claim 5: it is not clear what sufficient time means. Sufficient for what?
- f) Claim 8: it is not clear at what point the embossing occurs.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Greenman et al (3235443).

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'443 teaches impregnating a paper with an aqueous emulsion of polymer, preferably acrylic material, to transparentize the paper (2:60-4:47). After impregnation, the paper is dried, which also cures the resin (4:4:61-66). The heat also serves as curing agent.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by FR 1399903.

'903 teaches transparentizing paper with a resin solution, drying (presumably with heat) and curing with UV and NH₃ (see Abstract).

9. Claims 1-2, 5-7, 9 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Petrosky (5849398)

'398 teaches transparentizing paper with a resin solution, which may be heated for better penetration. The resin is applied by a screen printing process, possibly to both sides of the paper, and then passed, at a speed of 30-100 meters/minute, to a heating station, for enhanced saturation, and to a UV curing station (3:27-4:64).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 2-4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenman et al (3235443).

‘443 is applied here for the reasons given above.

‘443 does not teach the details of the process, such as a second application or a second heat source, rate at which the paper travels or an embossing operation. However, these are conventional parameters of a transparentizing operation, including controlling the rate at which the paper is exposed to heat to dry and cure, and it would have been obvious to one of ordinary skill in the art to have controlled and optimized the ‘443 process, thru no more than routine experimentation.

12. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 1399903.

‘903 is applied here for the reasons given above.

‘903 does not teach the details of the process, such as a second application or a second heat source, rate at which the paper travels or an embossing operation. However, these are conventional parameters of a transparentizing operation, including controlling the rate at which the paper is exposed to heat to dry and UV/NH₃ to cure, and it would have been obvious to one of ordinary skill in the art to have controlled and optimized the ‘903 process, thru no more than routine experimentation.

13. Claims 3-4, 8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrosky (5849398).

‘398 is applied here for the reasons given above.

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The line speed of '398 overlaps that claimed by applicant.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

'398 does not teach a second curing agent or a second heat source or an embossing operation. However, these are conventional parameters of a transparentizing operation, and it would have been obvious to one of ordinary skill in the art to have controlled and optimized the '398 process, thru no more than routine experimentation.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma C. Cameron whose telephone number is 703-308-2330. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Erma Cameron
ERMA CAMERON
PRIMARY EXAMINER

Erma C. Cameron
Primary Examiner
Art Unit 1762

February 8, 2003